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In re Patent No. 6,223,937
Issued: May 1, 2001
Application No.: 09/441,869
Filing Date: November 17, 1999
Attorney Docket No. 337/1/003

: REQUEST FOR INFORMATION
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This is a request for information in response to the petition under 37 CFR 1.378(b), filed June 28, 2011, to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petitions currently of record. No additional fees are due.

The patent issued May 1, 2001. The 3.5 year maintenance fee could have been paid from May 1, 2004, through November 1, 2004, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from November 2, 2004, to May 1, 2005. Petitioner did not do so. Accordingly, the patent expired at midnight on May 1, 2005. It is also noted that the 7.5-year maintenance fee was missed as it was not paid by May 1, 2009.

Petitioner is required to address the following point:

- It is noted that in California Medical Products v. Technol Med. Prod., 921 F. Supp. 1219, 1259 (D.Del. 1995), the court determined, in part, that a patent holder's reliance upon an attorney does not provide the patent holder with an absolute defense, but rather shifts the focus to whether the attorney acted reasonably and prudently. It is noted that the subject patent was expired for five years before the first petition to reinstate the patent was filed. By the instant petition, and the prior petitions, petitioner appears to argue that the patent holder, Iron Out, Inc., bears no responsibility for the missed maintenance fee payment and subsequent five years that the patent remained expired. Certainly, a patent holder is entitled to retain a law firm to track and pay maintenance fees and to rely on the actions of that law firm. However, retaining a law firm to track and pay maintenance fees does not absolve the patent holder of any responsibility to treat the patent as its most important business especially in trying to establish that the entire delay in paying the maintenance fee was unavoidable—from the due date for the maintenance fee until the filing of a grantable petition under 37 CFR 1.378(b) or (e). Further, it is well established that a patent holder is bound by any errors that may have been committed by his attorney.

Notwithstanding, petitioner is required to address the point of whether it is reasonable to expect that, at some point during the five year period from May 2005 until June 2010, the patent holder may have performed its own audit to discover the expiration of the patent.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition Attorney
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